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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER
ANDERSON, REBECCA L

ART UNIT	PAPER NUMBER
1626	

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15

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/961,347	JANIN ET AL.	
	Examin r	Art Unit	
	Rebecca L Anderson	1626	

-- The MAILING DATE of this communication appears on th cov r sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *21 and 23-43* is/are pending in the application.

4a) Of the above claim(s) *24,25 and 29* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *21,23,27,28,30-32 and 40-43* is/are rejected.

7)☐ Claim(s) *26 and 33-39* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☒ Certified copies of the priority documents have been received in Application No. *08/608,519* .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

DETAILED ACTION

Claims 21 and 23-43 are currently pending in the instant application. Claim 22, claims 21 and 23 were amended and claims 41-43 were added in the amendment filed 22 April 2003.

Election/Restrictions

In the response filed 22 April 2003, applicants have noted that the restriction requirement mailed January 7, 2002 did not clearly state that the species election was on the basis of the type of reactant reacted with the hydrocarbyl compound and that it was assumed that the species election was simply requested as an expedient to simplify the search and examination and that upon an indication of allowable subject matter, the other species covered by the claims would also be searched and examined. It is noted that the restriction requirement mailed January 7, 2002, stated that the general groups I-III included patentably distinct species and gave examples of the process of example 7 and the process of example 8. These processes are species, a logical division of a genus, of one of the general processes and differ in the reactants, i.e. one has a peroxide reactant while the other has a halogen reactant. It is also pointed out that the restriction requirement is made under 35 USC 121, which gives the Commissioner (Director) the authority to limit the examination of an application where two or more independent and distinct inventions are claimed to only one invention. The examiner has indicated that more than one independent and distinct invention is claimed in this application and has restricted (limited) claimed subject matter accordingly. Thus the requirement to restrict the claims in this application is

predicated on the fact that the claimed subject matter involves more than one independent and distinct invention. Nowhere do applicants point out and give reasons why the claims do not involve independent or distinct subject matter. So, here we have claims which involve more than one independent or distinct invention. Under 35 USC 121, the claims may be restricted and the examination limited to a restricted invention. Accordingly, restriction as has been presented in this application is proper. The requirement to restrict is repeated and made final.

Applicants have also requested clarification of the species election requirement by an indication of which species are considered to be patentable distinct from the elected species (the elected species is the species that if clear from the following rejections and objections, would be considered allowable over the prior art of record). The election of the species of the process of example 2 in Paper No. 10 resulted in the generic concept, for search and examination, which is the process as found in claim 21 wherein the hydrocarbyl compound is reacted with a halogen reactant. The species which is considered to be patentable distinct from the elected invention, the process which is not within the generic concept, which is independent and distinct from the generic concept and does not have unity with the species elected and is therefore withdrawn by means of a restriction requirement within the claim is the process as found in claim 21 wherein the hydrocarbyl compound is reacted with a peroxide compound. The subject matter of claims 21, 23, 26-28 and 30-43 that is not drawn to the elected invention, the process wherein the hydrocarbyl compound is reacted with a halogen reactant and claims 24, 25 and 29 stands withdrawn under 37 CFR 1.142(b) as being

for non elected subject matter, for reasons essentially those given in the last Office actions. The above mentioned withdrawn process which is withdrawn from consideration as being for non elected subject matter differs materially reagents and reaction conditions from the elected invention and are chemically recognized to differ in structure and function.

Response to Amendment

Applicants amendment to claim 21, by including the limitations as found in now cancelled claim 22, has overcome the 35 USC 102(b) rejection of claims 21, 30 and 31.

Maintained Double Patenting Rejection

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b). It is noted that on page 5 of the amendment filed 22 April 2003, applicant has indicated that they are willing to consider

filing a Terminal Disclaimer to obviate these rejections upon an indication that the claims are allowable. It is respectively noted that applicants have requested that these rejections be held in abeyance until such time as the pending claims are indicted to be allowable, however, these rejections are maintained.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 21, 23, 26-28, 32, 40 and newly added claims 41-43 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1, 5, 10 and 13 of U.S. Patent No. 6316636. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claims disclose a process for the synthesis of a fluorocarbon compound comprising reacting: a hydrocarbyl compound (for example, R-CFX-Y(O)r-CR'R"-Ar, claim 21 and newly added claim 42, wherein Ar is a lower alkyl radical having not more than 10 carbon atoms, claim 23 containing an sp3-hybridized halophoric carbon atom bearing at least two halogen atom substituents (for example comprising a perfluorinated carbon atom vicinal to the sulfur atom, claim 32), at least one halogen atom having an atomic number greater than that of fluorine and said halophoric carbon atom being bonded to at least one chalcogen (such as sulfur, claim 27, in the form of a sulfone, claim 28); with a halogen reactant, such as halogen or a halogen-base complex (claim 21 and newly added claims 41-43). Claim 40 discloses that the reaction can be carried out at temperatures at most equal to 100 degrees Celsius.

The claims (1, 5, 10 and 13) of US Patent No. 6316636 disclose a process for the synthesis of a fluorocarbon compound, comprising reacting a hydrocarbyl compound containing an sp3-hybridized halophoric carbon atom bearing at least two halogen atom substituents at least one halogen atom having an atomic number greater than that of fluorine (for example said halophoric carbon atom bearing three halogen atoms selected from chlorine and fluorine, claim 5) and said halophoric carbon atom being bonded to a sulfur atom (such as a sulfur atom as part of a sulfone moiety, claim 10) with a Bronstedt base wherein said Bronstedt base is a trivalent hydrocarbon derivative of elements of column VB (such as an aromatic heterocycle, claim 13) of the Periodic table complexed with a defined amount n of hydrofluoric acid (claim 1).

The difference between the claims at issue and the US Patent claims is that the claims at issue generically encompass the US Patent claims. By using the term "halogen reactant" and "halogen-base complex" the claims at issue encompass a Bronstedt base complexed with a defined amount of hydrofluoric acid claimed in the US Patent. Also, the specifications show the preferences of the halogen reactant and the Bronstedt base complex to be that of Example 2, the instant elected species, wherein the reagent is a pyridine-HF complex (column 14 of US Patent). The temperature for the reaction with the pyridine-HF complex can be seen in Table II as 100 degrees Celsius. Example 2 also shows the preference for a hydrocarbyl compound with Ar as lower aryl radical having less than 10 carbon atoms.

Therefore, although the claims are not identical, with the support of the preferences of the specification and the fact that the instant claims encompass that as

claimed in the US Patent, the processes for the synthesis of a fluorocarbon compound as instantly claimed and as claimed in US Patent No. 6316636 are obvious over one another.

Claim Objections

Claims 21, 23, 26-28 and 30-43 are objected to as containing non-elected subject matter. The claims presented drawn solely to the elected subject matter as indicated supra, and overcoming the above mentioned rejections would appear allowable.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Rebecca L. Anderson whose telephone number is (703) 605-1157. Mrs. Anderson can normally be reached Monday through Friday 7:00AM to 3:30PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Mr. Joseph McKane, can be reached at (703) 308-4537.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone numbers are (703) 308-1235 and (703) 308-0196.

A facsimile center has been established. The hours of operation are Monday through Friday, 8:45AM to 4:45PM. The telecopier numbers for accessing the facsimile machine are (703) 308-4242, (703) 305-3592, and (703) 305-3014.

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